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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/539,362

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Ralph Kurt

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08/17/2009

PHILIPS INTELLECTUAL PROPERTY & STANDARDS

P.O. BOX 3001

BRIARCLIFF MANOR, NY 10510

EXAMINER

MULVANEY, ELIZABETH EVANS

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

08/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,362	Applicant(s) KURT ET AL.	
	Examiner Elizabeth E. Mulvaney	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-11 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/09 has been entered.

Response to Arguments

Applicant had included the limitation “wherein a distance between a surface of the as-deposited information layer and a surface of said at least one additional layer is adjusted to that interference is obtained between radiation reflected from the surface of the as-deposited layer and from the surface of the additional layer”. The specification shows that this is achieved by adjusting the thickness of the recording layers or by including a layer between the reflective layer and the recording layer. US 2003/0190551 not only has recording layers which fall within applicant's disclosed thickness range (3-70nm), but the reference also includes a layer between the reflective layer and recording layer. See Working Examples. The reference does not include the specific alloy combinations as claimed. However, US 6,033,752 shows that these are known, such as Bi-Sn or In-Sn. See col. 6-7. Therefore, it would have been obvious to one of ordinary skill in the art to substitute the alloy combination of the '752 reference for the alloy combination of the '551

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reference. The substitution of one known recording material for another would yield predictable results.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 19, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims refer to “a surface” of the as-deposited layer and ‘a surface” of the additional layer. This could refer to either the light-incident surface of the layers or the back surface of the layers. The specification implies that these are the light-incident surfaces. Clarification is required.

Claim 18 provides for the use of a medium, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 9-11, 13-14, 16-18 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0190551.

The reference discloses a recording medium comprising a substrate, a reflective layer, a dielectric layer, a two-layered recording layer, a dielectric layer and a cover layer. The reflective layer and first dielectric layer are equivalent to applicant's "additional" layers. The first dielectric layer can also be equivalent to applicant's "spacer" layer. See Figure 3 and explanation thereof. The thickness of the recording layers falls within applicant's disclosed range. Therefore, the medium would be capable of achieving the interference effect claimed. The DVD is recorded upon with a laser which mixes the two layer of the recording layer to form recording marks. Reading is performed by detecting a difference in reflection of the recorded and unrecorded portions. See [0120].

Claims 2-7 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2003/0190551 as applied to claim 1 above, and further in view of US 6,033,752.

The '551 reference discloses the medium and method as described in the above rejection. It is recognized that the reference does not disclose the claimed combination of alloying materials. However, the '752 reference shows that these combinations, such as Bi-Sn or In-Sn are known. See

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cols. 6-7. Therefore, it would have been obvious to one of ordinary skill in the art to substitute the alloy combination of the '752 reference for the alloy combination of the '551 reference. The substitution of one known recording material for another would yield predictable results. Further, the '752 reference show that it is known to utilized double-sided media in increase the recording capacity.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth E. Mulvaney whose telephone number is 571-272-1527. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth E. Mulvaney/

Primary Examiner, Art Unit 1794

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